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Paper No. 8

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MAY 2 1 2003

OFFICE OF PETITIONS

In re Application of :
Kiyoshi Sato, Toshinori Watanabe, Hideki :
Gochou, Kiyoshi Kobayashi, Toru :
Takahashi, Hisayuki Yazawa, and Masaki :
Ikegami :
Application No. 09/802,314 :
Filed: March 8, 2001 :
Attorney Docket No. 9281/3900 :
Title: THIN-FILM MAGNETIC HEAD :
APPROPRIATELY SUPPRESSING :
SIDE FRINGING AND METHOD FOR :
FABRICATING THE SAME :

DECISION ON RENEWED
PETITION UNDER
UNDER 37 C.F.R. §1.47(a) and
PETITION UNDER
37 C.F.R. §1.55(c)

This is in response to the renewed petition under 37 CFR §1.47(a)¹, filed February 14, 2002, and the petition under 37 C.F.R. §1.55(c).

The office regrets the delay in the issuance of this decision.

Regarding the renewed petition under 37 C.F.R. §1.47(a), the petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR

¹ A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application;
- (3) a statement of the last known address of the non-signing inventors;
- (4) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review;
- (5) proof that the non-signing inventor refuses to sign the oath or declaration after having been presented with the application papers if the inventor refuses to sign, or proof that diligent efforts have been made to locate the non-signing inventor if he or she cannot be found, and;
- (6) a declaration which complies with 37 CFR §1.63.

1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Second Renewed Petition under 37 CFR 1.47(a)."

The above-identified application was filed on March 8, 2001, without an executed oath or declaration and identifying Kiyoshi Sato, Toshinori Watanabe, Hideki Gochou, Kiyoshi Kobayashi, Toru Takahashi, Hisayuki Yazawa, and Masaki Ikegami as joint inventors. Accordingly, on April 13, 2001, a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" was mailed, requiring an executed oath or declaration in compliance with §1.63, as well as the statutory basic filing fee of \$710, the fee for filing a late oath or declaration of \$130. This Notice set a two-month period for reply.

The original petition, filed on August 16, 2001, was dismissed in a decision mailed on October 10, 2001, for failure to establish requirement (6) above. The petition stated that the non-signing inventor had died, and that his two heirs had signed the declaration on his behalf. The decision indicated that the declaration was not acceptable, in that it failed to list the deceased non-signing inventor, and instead listed both of his heirs as joint inventors. This is not acceptable, in that 37 CFR 1.63(a)(2) requires that each inventor be identified on the declaration. The following section of 66 FR 54604 was included.

Section 1.44: Section 1.44 is removed and reserved to eliminate the requirement that proof of the power or authority of the legal representative be recorded in the Office or filed in an application under §§ 1.42 or 1.43. Although proof of authority is no longer required to be submitted to the Office, applicants may wish to consider obtaining proof of authority of the legal representative and recording such a document with any assignment documents for record-keeping purposes. In order to make a patent application on behalf of a deceased or incapacitated inventor, **the legal representative may now simply sign the § 1.63 oath or declaration** (which includes the full name and citizenship of the deceased inventor as well as the residence and mailing address, if not provided on an application data sheet) as the legal representative of the particular inventor with the title "Legal Representative" placed under the signature. In other words, in a signature block containing the deceased or incapacitated inventor's name, the legal representative will sign "for" the deceased or incapacitated inventor supplying the representative's name and stating that he or she is the legal representative. In addition, the legal representative should provide his or her mailing address so that the Office can directly communicate with the legal representative if necessary. See § 1.64(b).

The deletion of the § 1.44 proof requirement for the legal representative of §§ 1.42 and 1.43 will be effective on the date of publication in the Federal Register with § 1.64 as to all pending papers under §§ 1.42 and 1.43 that have not had the proof requirement satisfied. If a requirement for proof of authority has been made by an examiner, the requirement can be satisfied by a reply referencing this final rule.

With the instant petition, petitioner had included two-month extension of time to make timely this response, as well as a declaration which properly lists the non-signing inventor, as well as his two heirs, and they are indicated as such. Unfortunately, these two heirs have failed to sign the declaration. As such, this renewed petition must be dismissed.

Regarding the petition filed under 37 CFR §1.55(c), requesting acceptance of an unintentionally delayed claim under 35 USC 119(a) through (d) for benefit of the filing

date of foreign Application No. 2000-065288 (Japanese Patent Application), filed on March 9, 2000, the petition is **GRANTED**.

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

- (1) the nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
- (2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date;
- (3) the surcharge as set forth in 37 CFR 1.17(t);
- (4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1)(i) and the date the claim was filed was unintentional. (The Commissioner may require additional information where there is a question whether the delay was unintentional); and
- (5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

The instant pending nonprovisional application was filed after November 29, 2000, and did not include a reference to the foreign application, for which benefit is now sought, within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Therefore, since the claim for priority is submitted after the period specified in 37 CFR 1.55(a)(1)(i), this is an appropriate petition under the provisions of 37 CFR 1.55(c).

The above-identified pending nonprovisional application was filed on March 8, 2001, which is after November 29, 2000 and within 12 months of (the filing date of the foreign application to which benefit is now being claimed). On September 17, 2001, an **unexecuted** oath/declaration was received which identifies the foreign application for which priority is claimed by application number, country and filing date. The required petition fee of \$1,280.00 was received with the petition. Regarding the statement of unintentional delay, 37 C.F.R. §1.55(c)(2) requires a statement that the entire delay between the date the claim was due and the date the claim was filed was unintentional. Since the statement contained in the instant petition varies from the language required by 37 C.F.R. §1.55(c)(2), the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. §1.55(c)(2) and petitioner must notify the Office if this is not a correct interpretation of the statement contained in the instant petition. All requirements being met, the petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority under 35 USC 119(a) through (d) is granted.

This application is being forwarded to Technology Center 2600 for examination in due course and for consideration by the examiner of record of the foreign priority claim under 35 USC 119(a) through (d) and 37 CFR 1.55(c).

The reply to this letter may be submitted by mail^{2,3}, hand-delivery⁴, or facsimile⁵.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Paul Shanoski at (703) 305-0011.

Christina Patricia Donnellon

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
United States Patent and Trademark Office

² Commissioner for Patents, Box DAC, Washington, DC 20231.

³ Note: as of May 1, 2003, the mailing address for addressing correspondence to the Office will change to: United States Patent and Trademark Office, PO Box 1450, Alexandria, VA, 22313-1450.

⁴ Office of Petitions, 2201 South Clark Place, Crystal Plaza 4, Suite 3C23, Arlington, VA 22202.

⁵ (703) 308-6916, Attn: Office of Petitions.